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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,989	10/23/2003	Ramiro Arrez	0343-0035	2465
26568	7590	11/03/2005	EXAMINER	
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD SUITE 2850 200 WEST ADAMS STREET CHICAGO, IL 60606			KEENAN, JAMES W	
			ART UNIT	PAPER NUMBER
			3652	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/691,989	Applicant(s) ARREZ ET AL.	
	Examiner James Keenan	Art Unit 3652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/10/04, 11/24/03</u> | 6) <input type="checkbox"/> Other: ____ |

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1. This application contains claims directed to the following patentably distinct species of the claimed invention:

A: Figures 1-8;

B: Figures 9-11.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-4 and 8 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

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the prior art, the evidence or admission may be used in a rejection under 35

U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Stephen Heller on 10/27/05 a provisional election was made without traverse to prosecute the invention of Species A, claims 5-7 and 9-13. Affirmation of this election must be made by applicant in replying to this Office action. No claims are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, since no claims read solely on Species B. However, the species requirement is presented in the event applicant later submits claims which are drawn only to Species B.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6-7 and 9-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 6 and 11, line 4, it is not clear which "ends" are being referred to.

In claim 9, line 6, "the ... second gripper arms" lacks antecedent basis;

and in line 10, "or" should apparently be --for--.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Szinte (US 5,833,428, cited by applicant).

Szinte shows in figures 8-10 a grasper for inverting and dumping a refuse receptacle, comprising support 150 mounted to a lifter 106, first and second gripper arms 152a-b, and actuator 154, wherein the gripper arms move between a first position in which they receive the refuse receptacle therebetween and a second position in which they "lay generally flat against the support for storage", as broadly claimed (see col. 14, line 46 to col. 15, line 3).

8. Claims 1, 2, 4, 6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Antal (US 4,722,651).

Antal shows a grasper mounted to a lifter which could be adapted, without modification, for inverting and dumping a refuse receptacle, comprising support 30, lifter 22, first and second gripper arms 27, 28, and hydraulic actuator 33, wherein the gripper

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arms move between a first position (fig. 3) in which they receive an article to be gripped therebetween and a second position in which they lay flat against the support for storage (fig. 4).

Re claim 2, the arms are considered to be "nested", as broadly claimed, when in the second position.

Re claim 4, either gripper arm can be seen as having an "elongated arm-receiving region", as broadly claimed, in which the other arm is located when in the second position, as shown in figure 4.

Re claim 6, since no specific "ends" are recited, the limitations are met by Antal because the fixed ends of the arms extend beyond the support.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 2, 4, and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szinte in view of Antal.

Szinte does not show the arms to nest together when in the second position.

Antal, as noted above, shows similar gripper arms with this feature.

It would have been obvious for one of ordinary skill in the art at the time of the invention to have modified Szinte such that the arms nested together when stored, as shown by Antal, as this would simply be an art recognized alternate equivalent means of compactly storing the arms.

Re claims 6 and 7, the features are shown substantially by Szinte. Although the arms define a continuous curve rather than a linear portion extending from the fixed end and an angled portion at the free end, the concept of having the free ends lay behind the plain of the support when in the second position to avoid obstructions is the same, and thus the particular shape of the arms is considered an obvious design expediency.

12. Claims 3, 5, and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szinte in view of Antal, as applied to claims 1, 2, 4, and 6-8 above, and further in view of Ahrens (US 5,398,983), Christenson (US 5,769,592), or Schreiber et al (US 6,821,074).

Szinte as modified does not show the first gripper arm to define an opening sized to receive the second gripper arm, or to comprise a pair of members defining a space therebetween in which the second gripper arm nests.

Ahrens (fig. 2), Christenson (figs. 4-5), and Schreiber et al (figs. 4-5) all show refuse receptacle gripper arms in the same environment as Szinte which comprise a first arm consisting at least partially of two spaced members defining an opening or space therebetween in which a second arm at least partially nests.

It would have been obvious for one of ordinary skill in the art at the time of the invention to have further modified the apparatus of Szinte such that the first arm thereof included two spaced members defining an opening in which the second arm could nest when in the second position, as shown by Ahrens, Christenson, or Schreiber et al, as this is a well known and desirable gripper arm configuration for refuse collecting vehicles.


13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Keenan whose telephone number is 571-272-6925. The examiner can normally be reached on (schedule varies).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eillen Lillis can be reached on 571-272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James Keenan
Primary Examiner
Art Unit 3652

jwk
10/28/05